

Serial No.: 09/918,326
Art Unit: 2137**REMARKS**

This is a full and timely response to the outstanding Office Action mailed March 15, 2006. Reconsideration and allowance of the application and presently pending claims 1-16 are respectfully requested.

1. Response to Rejections of Claim Under 35 U.S.C. §102

Claim 10 has been rejected under 35 U.S.C. §102(e) as being anticipated by *Mazzagatte* (U.S. Patent No. 6,862,583). Applicants respectfully traverse this rejection.

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed subject matter must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. §102(e). In the present case, not every feature of the claimed subject matter is represented in the *Mazzagatte* reference. Applicants discuss the *Mazzagatte* reference and Applicants' claimed subject matter in the following.

As provided in independent claim 10, Applicants claim:

In a facsimile machine adapted for receiving and printing out digital documents, a device comprising:

a store of digital certificates, each certificate being associated with a most recent sender of a received digital document; and

an audit log comprising a list of received document entries, each entry containing a reference to one of the certificates in the store and a unique identifier associated with a received digital document, *wherein:*

the received digital document and a digital certificate of a most recent sender of the received digital document are received contemporaneously by the facsimile machine; and

the facsimile machine is configured to print the received digital document upon the most recent sender of the received digital document being authenticated.

(Emphasis added).

Applicants respectfully submit that independent claim 10 is allowable for at least the reason that *Mazzagatte* does not disclose, teach, or suggest at least that "the facsimile machine is configured to print the received digital document upon the most recent sender of the received digital document being authenticated," as recited and emphasized above in claim 10.

Serial No.: 09/918,326

Art Unit: 2137

In making the rejection, the Office Action states that "Mazzagatte teaches a method of authenticated secure printing in which a print node . . . waits for an intended recipient to arrive at the printer and present proper authentication. Once the intended recipient is authenticated, the printer then determines whether there are any print jobs queued for the intended recipient, and the print node may accordingly print a document." Office Action, page 3.

Applicants agree that *Mazzagatte* seemingly teaches the foregoing. For example, *Mazzagatte* states that the "print node then waits for the intended recipient to arrive at the printer and present the proper authentication information in order to retrieve the print job and have it printed." Col. 9, lines 31-35.

However, in contrast, the claim recites that a "facsimile machine is configured to print the received digital document upon the most recent sender of the received digital document being authenticated" and not the intended recipient. Therefore, *Mazzagatte* does not teach or suggest all of the claimed features.

For at least this reason, claim 10 is not anticipated by *Mazzagatte*, and the rejection should be withdrawn.

2. Response to Rejection of Claims Under 35 U.S.C. §103

In the Office Action, claims 1-4, 9, and 11-16 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Mazzagatte* in view of *Slick* (U.S. Patent No. 7,003,667). Claims 5-7 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Mazzagatte* in view of *Slick* in further view of *Fischer* (EP Patent 036867B1). Claim 8 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Mazzagatte* in view of *Slick* in further view of *Mandelbaum* (EP Patent No. 0671830A2). It is well-established at law that, for a proper rejection of a claim under 35 U.S.C. §103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly or explicitly, all elements/features/steps of the claim at issue. See, e.g., *In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

Serial No.: 09/918,326
Art Unit: 2137

a. Claim 1

As provided in independent claim 1, Applicants claim:

A document printout device for receiving and printing out digital documents, the printout device comprising:

a store of digital certificates, each certificate being associated with a received digital document and a most recent sender of the received digital document;

an audit log comprising a list of received document entries, each entry containing a reference to one of the certificates in the store, an encrypted digest corresponding to the received digital document of that entry, and a unique identifier associated with the received digital documents;

a decryption algorithm for decrypting the received encrypted digest associated with one of the received digital document selected for verification; and

a hash algorithm for creating a digest of the selected digital document such that when the created digest corresponds to the decrypted digest, the digital certificate of the most recent sender is authenticated, wherein:

the received digital document, the received encrypted digest associated with the received digital document, and the digital certificate associated with the received digital document are received contemporaneously by the document printout device; and

the document printout device is configured to print the received digital document upon the digital certificate of the most recent sender being authenticated.

(Emphasis added).

Applicants respectfully submit that independent claim 1 is allowable for at least the reason that *Mazzagatte* in view of *Slick* does not disclose, teach, or suggest at least that "the document printout device is configured to print the received digital document upon the digital certificate of the most recent sender being authenticated," as recited and emphasized above in claim 1.

For example, *Mazzagatte* states that the "print node then waits for the intended recipient to arrive at the printer and present the proper authentication information in order to retrieve the print job and have it printed." Col. 9, lines 31-35. However, in contrast, the claim recites that "the document printout device is configured to print the received digital document upon the digital certificate of the most recent sender being authenticated" and not the intended recipient. (Emphasis added).

Since *Slick* is legally inadequate to cure the deficiencies of the *Mazzagatte*, a *prima facie* case establishing an obviousness rejection by *Mazzagatte* in view of *Slick*

Serial No.: 09/918,326

Art Unit: 2137

has not been made. Accordingly, claim 1 is not obvious under the proposed combination of *Mazzagatte* in view of *Slick*, and the rejection should be withdrawn.

b. Claims 2-9 and 12-13

Because independent claim 1 is allowable over the cited art of record, dependent claims 2-9 and 12-13 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2-9 and 12-13 contain all the elements and features of independent claim 1. Further, *Fischer* and *Mandelbaum* are legally inadequate to the cure deficiencies of the *Mazzagatte* and *Slick* references with regard to claims 5-7, 8, and others. For at least this reason, the rejections of claims 2-9 and 12-13 should be withdrawn.

Additionally and notwithstanding the foregoing reasons for the allowability of claims 2-9 and 12-13, these dependent claims recite further features/steps and/or combinations of features/steps (as is apparent by examination of the claims themselves) that are patentably distinct from the cited art of record. Hence, there are other reasons why these dependent claims are allowable.

c. Claim 11

As provided in independent claim 11, Applicants claim:

A method of authenticating the identity of a sender of a received digital document, the method comprising:

using a unique identifier printed on the received document to search for a corresponding record in a list of received document records;

referencing a digital certificate associated with the selected record, the certificate being one of a store of certificates of received documents and each digital certificate being associated with a most recent sender of a received digital document;

receiving an encrypted digest of the received digital document;

decrypting the encrypted digest;

computing a value of a second digest from the received digital document;

comparing the computed value of the second digest with a value of the decrypted digest;

carrying out an on-line authentication of the certificate when the computed value of the second digest corresponds with the value of the decrypted digest;

printing the received digital document if the certificate of the most recent sender of the received digital document is authenticated,

Serial No.: 09/918,326

Art Unit: 2137

wherein the received digital document, the received encrypted digest associated with the received digital document, and the digital certificate associated with the received digital document are received contemporaneously.

(Emphasis added).

Applicants respectfully submit that independent claim 11 is allowable for at least the reason that *Mazzagatte* in view of *Slick* does not disclose, teach, or suggest at least "printing the received digital document if the certificate of the most recent sender of the received digital document is authenticated, wherein the received digital document, the received encrypted digest associated with the received digital document, and the digital certificate associated with the received digital document are received contemporaneously," as recited and emphasized above in claim 11.

For example, *Mazzagatte* states that the "print node then waits for the intended recipient to arrive at the printer and present the proper authentication information in order to retrieve the print job and have it printed." Col. 9, lines 31-35 (Emphasis added). However, in contrast, the claim recites that "printing the received digital document if the certificate of the most recent sender of the received digital document is authenticated, wherein the received digital document, the received encrypted digest associated with the received digital document, and the digital certificate associated with the received digital document are received contemporaneously." (Emphasis added). Therefore, *Mazzagatte* does not teach or suggest at least the above-recited feature.

Since *Slick* is legally inadequate to cure the deficiencies of the *Mazzagatte*, a *prima facie* case establishing an obviousness rejection by *Mazzagatte* in view of *Slick* has not been made. Accordingly, claim 11 is not obvious under the proposed combination of *Mazzagatte* in view of *Slick*, and the rejection should be withdrawn.

d. Claims 14-16

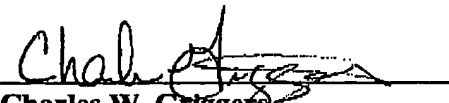
Because independent claim 11 is allowable over the cited art of record, dependent claims 14-16 (which depend from independent claim 11) are allowable as a matter of law for at least the reason that dependent claims 14-16 contain all the steps and features of independent claim 11. For at least this reason, the rejections of claims 14-16 should be withdrawn.

Serial No.: 09/918,326
Art Unit: 2137

CONCLUSION

For at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,


Charles W. Griggers
Reg. No. 47,283